

**REMARKS/ARGUMENTS**

**Objections**

Claims 1, 4, 9, 12, 13, 15 and 16 are objected to due to various informalities. These informalities have been addressed in the amendments. Specifically, Claims 12 and 13 now begin with "A". Claims 15 and 16 now begin with "The". The typographical error "akkynyl" in claims 1, 4, 9 and 12 has been amended to "alkynyl".

Claim 12 is objected as being a substantial duplicate of claim 11. It is further pointed out that claim 11 was previously cancelled and included in applicants' recent amendment in error. Applicants regret that claim 11 was erroneously presented. However, the fact that claim 11 has been cancelled obviates the objection to claim 12 since claim 12 is not a duplicate of any pending claim. It is therefore respectfully requested that the objection to claim 12 be reconsidered and withdrawn.

Claims 2, 8 and 14 are objected to as depending from claims which are themselves objected to. As noted in the preceding two paragraphs, applicants have addressed these objections, and it is believed that claims 2, 8 and 14 should no longer depend from objectionable claims.

**35 USC § 112**

Claim 9 is rejected under section 112, first paragraph for allegedly not being enabling for the prevention of pain. Applicants traverse this rejection. One skilled in the art, for instance a medical doctor seeking to prevent the onset of pain symptoms in a patient, would be in a position to know when pain symptoms are likely to occur for a particular patient.

Moreover, the specification *does* provide support for pain prevention throughout, most notably at page 21, first and second paragraph, reproduced for the convenience of the Examiner here:

In still another embodiment of the invention, there are provided methods for preventing disease conditions in a subject at risk thereof, said method comprising administering to said subject a therapeutically effective amount of at least one of the heterocyclic compounds described above in accordance with invention methods for modulating the activity of excitatory amino acid receptors.

As used herein, the phrase "preventing disease conditions" refers to preventing a disease, disorder or condition from occurring in a subject who may be at risk for the disease, but has not yet been diagnosed as having the disease. Those of skill in the art will understand that a variety of methods may be used to determine a subject at risk for a disease, and that whether a subject is at risk for a disease will depend on a variety of factors known to those of skill in the art, including genetic make-up of the subject, age, body weight, sex, diet, general health, occupation, exposure to environmental conditions, marital status, and the like, of the subject.

Further with respect to claim 9, the Examiner contends that the term "prevention" "indicates that the subject will never again suffer pain or that the drug prevents pain no matter what the cause". This is not how the term "prevention" is understood in the art. Rather, one skilled in the art would understand that "prevention" relates to conditions such as pain wherein mGluR5 plays a role. Similarly, the skilled artisan would immediately recognize that the duration of the preventative effect would not be unlimited, but would be related to the pharmacological properties of the compound.

It is pointed out that numerous issued patents include claims directed to the prevention of pain. The undersigned was able to identify many of these patents simply by entering the following search in the USPTO advanced patent search database: *((ACLM/prevent OR ACLM/prevention) AND ACLM/pain)*. A listing of the first 50 hits (out of 260) from this search is attached. A brief review of these patents will establish that pain prevention is routinely claimed. This could not be the case if prevention was understood in


the art to mean pain prevention of never ending duration, or the prevention of pain from any possible cause or source.

Claims 15 and 16 are rejected for the reasons set forth in prior office actions relative to claim 5. Again, applicants traverse. The rationale for this rejection is that since claim 5 was earlier rejected, and since some of the language in claims 15 and 16 was originally found in claim 5, claims 15 and 16 must be rejectable for the same reasons. This is illogical. Original claim 5 was rejected, in two office actions in 2001, because it depended from claim 4, which was rejected for prior art reasons. Original claim 5 was not rejected for any other reasons. Today, claim 4 is in condition for allowance (other than a minor objection, already addressed above.) There is no reason to maintain the rejections of claims 15 and 16 based on two year old rejections that have long since been addressed.

### Conclusion

Applicants respectfully submit that the application is in condition for allowance and request a Notice to that effect. Attorney for Applicants can be reached at the telephone number and address below. Correspondence should be sent to the address below. Any additional fees or deficiency in fees required should be taken from Merck Deposit Account No. **13-2755**.

Respectfully submitted,

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Date: October 2, 2003